

## REMARKS

### Elected Subject Matter

Independent claims 39, 61, 67 and 71 and dependent claim 74 have been amended to conform to the elected subject matter. Dependent claims 42, 45, 51, 54, 59 and 72 new claims 79-89 also conform to the elected subject matter.

### Expansion of the Elected Group

All remaining pending claims (1, 3, 4, 6-27, 33-38, 40, 44, 48-50, 53, 55, 58, 62, 64, 65, 68-70, 73-78) conform to the elected species but for the substituents required on B (t-butyl or trifluoromethyl). Applicants maintain that the definition for the elected group should be modified to eliminate the required substituents on B and that all pending claims be examined. The pending claims define compounds with the common structural skeleton:

phenyl-urea-phenyl-M (oxygen or sulfur) - L<sup>1</sup> (phenyl, pyridinyl or pyrimidinyl)  
which is substituted by -C(O)NR<sup>a</sup>R<sup>b</sup> on the group corresponding to L<sup>1</sup>. It has not been shown to be an undue burden to extend the examination to the full scope of the pending claims where the compounds defined therein have this common core.

The required substituents on L<sup>1</sup> have never been acknowledged by the USPTO as a common feature of the compounds claimed herein. When the restriction requirement was made, only the urea group was identified as the core of the invention. In the office action dated January 17, 2003, urea compounds said to fall with the scope of the invention did not have one of the required substituents on the group corresponding to L<sup>1</sup>. Applicants submit that if the required substituent on L<sup>1</sup> is considered, the search would not be burdensome such that it would not be an undue burden to expand the scope of the elected group and eliminate the required substituents on B.

### Claims 71-78

Applicants maintain that Claims 71-78 are distinct in scope from the other pending claims and are not redundant. Claims 71 and 72 define compounds which conform to the elected subject matter and are distinct in scope from claim 39 in that, for example, L<sup>1</sup> can be phenyl or pyridinyl in the compounds defined in claim 71 but only pyridinyl in claim 39. Compound claims 73 and 74 are distinct from independent claims 1 and 38 in that, for example, L<sup>1</sup> is substituted only by -C(O)NR<sub>4</sub>R<sub>b</sub>, where as claims 1 and 38 provide for

optional additional substitution of L<sup>1</sup>. Claims 76 and 77 define pharmaceutical compositions which specify their utility in treating cancer unlike claim 55. Claim 77 further defines pharmaceutical compositions which specify the use of the salt form of the ureas and claim 78 defines compounds wherein the scope of the definition for R<sub>a</sub> and R<sub>b</sub> is different from that in claims 1, 38 and 39. Since claims 71-78 are not redundant to the earlier filed claims, they should be examined.

### **Claim Amendments**

The definitions for elements B, L, L<sup>1</sup>, and M have been amended in claims 1, 3, 6, 38, 71 and 78 to conform to the definitions given to these elements for the elected subject matter. The elements R<sub>x</sub>, R<sup>7</sup> and R<sup>7'</sup> have been narrowed in claims 1 and 38 to encourage expansion of the elected subject matter to include these claims.

In Claims 39, 71 and 74, the definition for the substituents on B have been amended to be consistent with the elected subject matter.

Claims 61 and 67 have been amended to delete compounds which do not fall within the scope of the elected invention and to include pharmaceutically acceptable salts of the compounds named.

Claim 55 has been amended to cancel unnecessary language in that the intended use of the pharmaceutical composition is not necessary to definitively describe the invention to one of ordinary skill in the art.

The remaining amendments to claims 6-9, 33-37, 39, 45, 67, 71, 73 and 74 have been made to correct minor errors, conform the language therein to the independent claims or differentiate the independent claims.

Claims 4, 40 and 42 have been amended to redefine the ortho positioned substituents. Applicants make this amendment to further prosecution of this application and do not concede that the rejection under 35 U.S.C. § 112, second paragraph has merit. By excluding -OH from the ortho position of the compounds defined, one skilled in the art will recognize that hydrogen or the substituents defined by W, other than OH, can appear at the ortho-positions of L. Similarly, hydrogen or the 1-3 substituents for B, other than OH, can appear at the ortho-positions of B.

The hetaryl substituents recited in claims 1, 38, 39 and 78 are elements which have been redefined to further prosecution of this application. Applicants do not concede the

merits of the rejection under 35 U.S.C. § 112, second paragraph. No evidence or reasons have been presented to doubt that any of the compounds claimed in claims 1, 38 or 39 are useful as disclosed or that any of the claimed compounds can not be made as disclosed. Such evidence or reasons are required to support the rejection, see, e.g., *In re Marzocchi*, 439 F.2d 220, 169 U.S.P.Q. 367 (CCPA 1971). Only unsupported conclusions are made in the latest office action and previous office actions with respect to the Wand factors. Applicants respectfully submit the rejection under 35 U.S.C. § 112 is not viable without such evidence and should be withdrawn irrespective of the amendments above. With the above amendments, the claims clearly satisfy the requirements of 35 U.S.C. § 112, first paragraph.

**New Claims**

New claims 79-88 define embodiments which conform to the elected subject matter.

claim 80 is consistent with the pending claims 22-27;

claim 81 is consistent with pending claims 33-37;

claims 82 and 88 are consistent with pending claim 55;

claims 83 and 86 are consistent with pending claims 51, 53 and 54;

claim 84 is consistent with pending claims 64 and 65;

claims 85 and 89 are consistent with pending claim 59; and

claim 87 is consistent with pending claim 45.

**Copending Application No. 10/071,248**

In that allowable subject matter has not been identified in this application, the obviousness type double patenting rejection is premature.

**Other Copending Applications**

The published applications identified by the examiner are listed below with a brief summary of the scope of the pending claims therein. Terminal disclaimers for these applications are either not required or premature. A copy of the pending claims for each application is also provided herewith as an attachment.

US 2002 042517, SERIAL NUMBER 09/948,915, FILED 09/10/01;

This application contains broad claims to ureas as claimed herein which are subject to a restriction requirement. The restriction requirement has been traversed and is still

contested. Applicants intend for the full scope of the original claims to be examined consistent with the international application.

US 2002 165394, SERIAL NUMBER 09/777,920, FILED 02/07/01;

This application contains claims to a subgenus of urea compounds wherein B is different.

US 2003 068223, SERIAL NUMBER 10/361,858, FILED 02/11/03;

This application contains claims directed to a method of treating diseases mediated by a VEGF-induced signal transduction pathway with ureas that encompass the compounds claimed herein.

US 2003 105091, SERIAL NUMBER 10/086,417, FILED 03/04/02;

This application contains claims to a method of treating p38 mediated diseases with ureas that encompass the compounds claimed herein.

US 2003 181442, SERIAL NUMBER 09/993,647, FILED 11/27/01;

This application contains claims to a subgenus of five urea compounds which are generically encompassed by the claims herein. An appeal brief was filed in this application. A copy of the Examiner's Answer is attached hereto.

US 2003 207872, SERIAL NUMBER 10/042,203, FILED 01/12/02;

This application contains claims to a subgenus of five urea compounds in the form of pharmaceutically acceptable salts which are encompassed by the claims herein.

US 2003 216396, SERIAL NUMBER 10/361,850, FILED 2/11/03;

This application contains claims directed to ureas which are in oxide form. The compounds of Serial No. 10/361,859 are excluded by proviso.

US 2003 216446, SERIAL NUMBER 10/361,859, FILED 02/11/03;

This application contains claims directed to ureas with a pyridinyl group having the nitrogen in oxide (oxo) form.

US 2003 232765, SERIAL NUMBER 10/308,187, FILED 12/03/02;

This application contains claims directed to combination therapies with ureas as claimed herein.

US 2004 102636, SERIAL NUMBER 10/060,936, FILED 02/01/02;

This application contains claims to a method of treating p38 mediated diseases with a broad genus of ureas which encompasses the compounds claimed herein. The application also contains claims to compounds which do not have the substituent  $-C(O)NR_aR_b$  on  $L^1$  and so do not encompass the compounds claimed herein.

US 2004 229937, SERIAL NUMBER 10/789,446, FILED 03/01/04;

This application contains claims directed to urea compounds wherein  $L^1$  is different.

US 2004 0235829, SERIAL NUMBER 10/788,029, FILED 02/27/04;

This application contains claims directed to urea compounds wherein the required substituent  $L^1$  is different.

US 2005 0032798, SERIAL NUMBER 10/788,405, FILED 3/1/04;

This application contains claims directed to urea derivatives.

US 2005 0038031, SERIAL NUMBER 10/788,426, FILED 03/01/04;

This application contains claims directed to urea compound wherein B is different.

US 2005 0038080, SERIAL NUMBER 10/895,985, FILED 07/22/04;

This application contains claims directed to a single urea and derivatives thereof within the scope of the claims herein.

US 2005 0059703, SERIAL NUMBER 10/848,567, FILED 05/19/04;

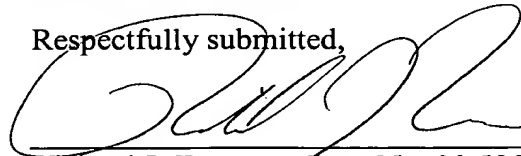
This application contains claims directed to methods for treating diseases using urea within the scope of the claims herein.

Based on the above remarks, applicants submit that all pending claims should be examined and that all claims satisfy the requirements of 35 U.S.C. § 112, first and second paragraphs. Terminal disclaimers over the copending applications identified above are either not necessary or premature.

In view of the above, favorable reconsideration is courteously requested. If there are any remaining issues which can be expedited by a telephone conference, the examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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